

REMARKS

Applicants respectfully request that the Examiner confirm that the official records of the Patent and Trademark Office have been corrected to indicate that this divisional application was filed on December 4, 2001. Additionally, Applicants ask that the records reflect that one of the applications from which the pending application claims priority, U.S. Serial No. 08/033,066, filed March 10, 1993, is abandoned. Applicants filed a Request for Corrected Filing Receipt on March 22, 2002, but the corrected filing receipt has not been received, and the incorrect filing date on the Official Action suggests that the corrections have not been made.

1. The pending claims are not unpatentable for obviousness-type double patenting.

Claims 1-3 and 5-7 having been cancelled herein, pending claims 4 and 8 are patentably-distinct under the judicially-created doctrine of obviousness-type double patenting over the claims of co-owned U.S. Patent Nos. 5,665,550, 6,083,746 or 6,326,488. Applicants thus request that the Examiner withdraw this ground of rejection.

2. The amended claims fulfill the requirements of 35 U.S.C. §112.

Claims 1-3 and 5-7 are cancelled herein in an effort to prosecute the pending claims to allowance. However, Applicants wish to make of record their views on the impropriety with which the Office has applied the written description requirement to the cancelled claims.

The Office Action cites MPEP Section 2163 (I.A) in support of the proposition that a biomolecule sequence (such as a synthetic peptide as instantly claimed) cannot be adequately described by recitation of its function and a method for preparing it, unless there is a known or disclosed correlation between the function and the structure of the sequence. While this may be true for claims to a biomolecule such as a polypeptide having a particular biological activity or a nucleic acid encoding such a polypeptide, the considerations behind the rule do not apply to the synthetic polypeptides disclosed and claimed in the instant application. This is because these peptides are associated with gain of activity through loss of function, analogous to biochemical inhibitors. The rule is sufficiently flexible to accommodate such peptides; the recited section of the rule is qualified by the phrase "*normally* is not a sufficient identifying characteristic for written description purposes." (*Emphasis added*) This is evidenced by actions of the Patent and Trademark Office, which has granted U.S. Patent Nos. 6,541,603 (issued April 1, 2003); 6,376,24 (issued April 23,

2002); 6,326,488 (issued December 4, 2001); 6,281,011 (issued August 28, 2001); 6,083,746 (issued July 4, 2000); 6,083,745 (issued July 4, 2000); 6,060,244 (issued May 9, 2000); and 6,043,340 (issued March 28, 2000). Refusal by the Patent Office to grant claims 1-3 and 5-7 in the instant application is wholly inconsistent with the existence of these eight presumptively valid U.S. patents, supported by similar disclosures.

Despite these views, which are fully supported by Federal Circuit case law as explicated in Applicants' previously-submitted response, and in an effort to expedite prosecution of the pending claims to allowance, Applicants have cancelled claims 1-3 and 5-7, and thus respectfully ask the Examiner to withdraw this ground of rejection.

CONCLUSION

Applicant believes that all requirements of patentability have been fully met, and allowance of the claims is respectfully solicited.

If the Examiner in charge of this application believes it to be helpful, he is invited to contact the undersigned attorney by telephone at (312) 913-0001.

Respectfully submitted,

McDonnell Boehnen Hulbert & Berghoff

By: 

Kevin E. Noonan, Ph.D.
Reg. No. 35,303

Dated: November 15, 2004